

REMARKS

The Final Office Action mailed April 15, 2008, has been received and reviewed. Claims 1 through 13, and 15 through 21 are currently pending in the application. Claims 1 through 13, and 15 through 21 stand rejected. Applicants propose to amend claims 1, 3, 11, 12, 15, 20, and 21, and respectfully request reconsideration of the application as proposed to be amended herein.

Claim Objections

Claim 2 is objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Appropriate correction has been made. Claim 2 has been cancelled. Therefore, the rejection is moot.

35 U.S.C. § 112 Claim Rejections

Claims 1 through 11 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More specifically, claims 1, 2, and 11 are rejected as failing to provide sufficient antecedent basis for the limitation “the second location.” Claim 2 has been cancelled and claims 1 and 11 have been amended to replace the phrase “second location” with “chemical testing facility.” Applicants respectfully request withdrawal of the rejection in view of the amendments.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,358,851 to Peck in view of U.S. Publication No. 2001/0053517 to Anton et al.

Claims 1 through 13, and 15 through 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Peck (U.S. Patent No. 5,358,851) in view of Anton et al. (U.S. Publication No. 2001/0053517). Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, the Examiner must determine whether

there is “an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-1741, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Further, rejections on obviousness grounds “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id* at 1741, quoting *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

Independent claim 1 has been amended to recite a method for assaying a chemical comprising: providing an extraction solution for dissolving a chemical of a solid, organic sample and a predetermined amount of an internal standard in a container; collecting a solid, organic sample at a crop storage location; placing the solid, organic sample in the container; transporting the container including the sample from the crop storage location to a chemical testing facility; quantitatively measuring an amount of the chemical in the extraction solution at the chemical testing facility; and comparing the amount of internal standard present in the container at the chemical testing facility with the amount of internal standard placed in the container at the crop storage location to obtain a calibration ratio.

Independent claim 12 has been amended to recite a method for analyzing a sprout inhibitor on a tuber comprising: collecting a tuber sample from the tuber at a potato storage facility; depositing the tuber sample into a container including an extraction solution; transporting the container including the tuber sample to a chemical testing facility; assaying the sprout inhibitor in the extraction solution at the chemical testing facility; placing a predetermined amount of an internal standard in the extraction solution; quantifying an amount of the internal standard in the extraction solution; and comparing the quantified amount of the internal standard

in the extraction solution in the container at the chemical testing facility with the predetermined amount of the internal standard placed in the extraction solution deposited in the container at the potato storage facility.

Peck does not teach or suggest collecting a solid, organic sample (as required by claim 1) or a tuber sample (as required by claim 12). Peck also does not teach or suggest transporting a container that includes the sample, extract solution, and internal standard from a first location to a chemical testing facility. Finally, as acknowledged by the Examiner, Peck does not teach or suggest use of an internal standard. Anton et al. is relied upon as disclosing a kit for collecting and analyzing an unknown sample, the kit including a known quantity of an internal standard that is used to “spike” the sample when the sample is collected. However, Anton et al. relates to methods and compositions used to assay a nucleic acid burden in tissue or other body compartments, specifically, the determination of HIV viral infections by determining viral burden. However, Anton et al. does not overcome the previously described deficiencies of Peck. Additionally, Anton et al. teaches a method of using an internal standard that accounts for analyte lost in a method of determining a specific nucleic acid sequence in a biological sample obtained from a human or mammalian subject. In contrast, claims 1 and 12 (and all of the claims depending therefrom) compare the amount of internal standard present in the container at the chemical testing facility with the amount of internal standard placed in the container at the crop storage facility to obtain a calibration ratio. Therefore, the use of internal standard is entirely different, as the present invention uses the internal standard to determine loss of chemical from the sample (tuber) during transport from the crop or potato storage facility to a chemical testing facility.

The nonobviousness of independent claims 1 and 12 precludes a rejection of claims 2-11, 13, and 15-21 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 1-13 and 15-21.

ENTRY OF AMENDMENTS

The proposed amendments to claims 1, 3, 11, 12, 15, 20, and 21 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

CONCLUSION

Claims 1, 3-13, and 15-21 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



Edgar R. Cataxinos
Registration No. 39,931
Attorney for Applicants
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: July 15, 2008
ERC/dlm:tlp

Document in ProLaw